Innovation and Technology Transfer in Research Institutions

Making the most out of your IP policy
Academia Mission

Why do we have universities?

Create & Spread Knowledge

- Human Capital
- Education
- Resources
- Knowledge

University

Societal value + technological innovations are natural outcomes of academia
Open Innovation

Technology moves forward through partnerships

New Industry/Economy

Industry reduces risk and cost by shifting early development to the wider global community

The smallest innovator in smallest institution in smallest country can have a BIG role in development and enterprise
New Paradigm

Modern Industry

Knowledge is a factor of production, just like raw materials

Knowledge Economy

Technology is a product!

How do we “push” a knowledge product?
# The “Emotional” Needs of Industry

<table>
<thead>
<tr>
<th>Legal certainty</th>
<th>There can be no ambiguity related rights and responsibilities</th>
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<tbody>
<tr>
<td>Risk clarity</td>
<td>A clear appreciation to where the limits of knowledge are and what is unknown</td>
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<tr>
<td>A rationale</td>
<td>Why should I do this? Does it make sense?</td>
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<tr>
<td>Empathy</td>
<td>I am investing and taking risks and my partners should understand and appreciate my positions</td>
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Institutional Preparedness

Policy
- IP regulations
- IP instructions
- Legal representation

Structure
- Focal point
- Responsible administrators
- Knowhow
IP Policy Essentials

Resolve Ownership
- e.g. the institution claims all IP generated through significant use of resources

Set Authorities
- e.g. the president has the authority to negotiate and sign licensing deals after receiving the recommendation from the council of deans

Mobilize Procedures
- e.g. disclosures are submitted electronically and must be addressed within 60 days
External funding with Ownership Implications

- **Contract Research/industry**
  - Naturally contractor owned IP

- **Co-development**
  - Co-owned

- **Donor funded**
  - Depends on Regulations, Probably Institution Owned

- **Government Body funded**
  - Probably Institution Owned
Structure: How to Establish a Tech Transfer Office

1. Draw it into the Org. Structure
2. Hire someone (or more)
3. Implement policies / instructions
### Step 1: Structure Considerations

**Form:**
- office, division, center, form

**Linked with:**
- dean, school, VP, PV, Pres.

**Structure:**
- people, divisions... etc.
## Step 2: The TT Officer

<table>
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<tr>
<th>Task</th>
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<tr>
<td>Spread Awareness</td>
</tr>
<tr>
<td>Vantage point over internal activities</td>
</tr>
<tr>
<td>Receive disclosures</td>
</tr>
<tr>
<td>Study disclosures</td>
</tr>
<tr>
<td>Involved in valuations</td>
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<tr>
<td>Aware of trends and developments</td>
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<tr>
<td>Provide opinions on IP</td>
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<tr>
<td>Draft or support drafting</td>
</tr>
<tr>
<td>Manage or support managing IP</td>
</tr>
<tr>
<td>Commercialization support</td>
</tr>
<tr>
<td>Manage marketing</td>
</tr>
<tr>
<td>Build strong internal and external networks</td>
</tr>
<tr>
<td>Manage and support relevant committees</td>
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<tr>
<td>Manage external relations</td>
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TTO Office Model for Jordan

Internal Interface
- Internal network
- Internal advice
- Implement regulations

Backoffice
- Drafting
- Prior art
- Management

External Interface
- Business network
- Partnerships
- Placements

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Dr. Mohammed Aljafari
IPC-O-iPARK Royal Scientific Society
m.aljafari@ipark.jo
The Basic Role of a Tech Transfer Officer

A good Tech Transfer officer is an excellent communicator

The more “languages” an officer has the better

Stability and training are critical (see AUTM, WIPO)

Science to Legal

Legal to Commercial

Commercial to Accounting

Accounting to Administration

Administration to Science
Step 3: the process

Receive more tech/legal support (?) ➔ Log assessment results ➔ Request more info (?) ➔ Preliminary Assessment ➔ Receive Disclosure

Asset Management ➔ Communicate with researcher ➔ Decision/recommendation ➔ Show to committee (?) ➔ Collect all finding

Decision/recommendation ➔ Negotiation ➔ Business Development
Processes to include in a policy

- Disclosure trigger clear
- Receiving function described
- Analyzing function described
- Protecting function described
- Managing function described
- Commercializing function described
- Awareness function described
- TTO office established
- TTO office responsibilities described
- TTO office activities described
- Clear sharing mechanisms and ratios
- Clear payment process
- Implications of Divestment
Important considerations

Legal certainty is not negotiable

Cooperative/empathetic approach

Authority must be in line with legal environment

Seek relationships, not deals
Plan A: Home country patent
Patenting for Commercialization

Plan B: EVERYWHERE
Plan C: Only attractive markets
Patenting for Commercialization

Plan D: Only the biggest market and home?
Why are you patenting???

For large industry/multi nationals
- Patent to protect

For everyone else
- Patents as a means for partnership!